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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,500	04/02/2001	Boaz Nitzan	1328	7527

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EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/822,500

Applicant(s)

NITZAN ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Previous rejections under USC 112 are withdrawn based on the applicant's amendments to the claims. The applicant has more specifically defined the scope of the claims by removing the narrow range limitations.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 6, 7, 9-18, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kukharskay et al (SU 1058453A).

2. Claims 6, 7, 9-12, 19, 20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Figov et al (GB 1,492,529).

3. Claims 6-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto et al (US 5,064,749).

4. Claims 6-12, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Gautier et al (US 4,540,448).

5. Claims 6, 7, 9-12, and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Herdt et al (US 6,121,219).

6. Claims 6, 7, 9-12, 19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Beggs et al (US 6,017,968).

Response to Arguments

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7. Applicant's arguments filed 10-9-02 have been fully considered but they are not persuasive. The applicant argues the following points: 1) Kukarskay discloses compositions used for a different intended use than the claimed composition; 2) Kukarskay teaches additional ingredients that would be detrimental to the composition; 3) the compositions of Figov are intended for a different use; 4) the individual components of Figov function differently than in the instant composition; 5) Matsumoto teaches a different intended use; 6) Gautier teaches cleaning solution not connected to the technology of the instant invention 7) Herdt teaches composition for a different intended use; 8) Beggs teaches compositions for different intended use; 9) In *Re Marshall* states "all material elements recited in a claim must be found" to meet 102 limitation.

8. Concerning arguments 1, and 3-9, the basis of all of the applicant's arguments rest on the recited case law *In re Marshall* that provides the basis for 102 rejections. The applicant has correctly cited the ruling of *In re Marshall* but has failed to recognize a key term in the ruling. The ruling states, as quoted by applicant, "all *material* (emphasis added) elements recited." It is not clear how the applicant's specific intended use qualifies as a *material* limitation. As the examiner has met all *material* limitations, the burden of prior art to recite all material limitations has been met.

9. The examiner finds ample support for this in both the MPEP and case law:

"It should be noted that intended use recitations and other types of functional language cannot be entirely disregarded. However, in composition claims, intended use must result in *structural difference* (emphasis added) between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (see

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MPEP 2111.02). Furthermore, applicant may not rely upon the preamble to distinguish his claimed composition from that of the prior art, *where the preamble does not constitute a limitation of a claim when it states a purpose or intended use* (emphasis added; see *Loctite Corp. V. Ultraseal Ltd.*, 781 F.2d 861, 868, 228 USPQ 90, 94 (Fed. Cir. 1985))."

Whether to treat a preamble as a limitation is a determination "resolved only on review of the entire[] . . . patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989); see also *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1572-73, 40 USPQ2d 1481, 1488 (Fed. Cir. 1996) ("Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.").

In general, a preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. *Pitney Bowes*, 182 F.3d at 1305. Conversely, a preamble is not limiting "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention." *Rowe v. Dror*, 112

Additionally, dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention. *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995) ("[W]hen the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects."). Likewise, when the preamble is essential to understand limitations or terms in the claim body, the preamble limits claim scope. *Pitney Bowes*, 182 F.3d at 1306. Further, when reciting additional structure or steps underscored as important by the specification, the preamble may operate as a claim limitation

Moreover, clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. See generally *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (A preamble may limit when employed to distinguish a new use of a prior art apparatus or process.). Without such

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reliance, however, a preamble generally is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1434, 54 USPQ2d 1129, 1136-37 (Fed. Cir. 2000) (preamble phrase "control apparatus" does not limit claim scope where it merely gives a name to the structurally complete invention). Thus, preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant.

Preambles describing the use of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure. *In re Gardiner*, 171 F.2d 313, 315-16, 80 USPQ 99, 101 (CCPA 1948) ("It is trite to state that the patentability of apparatus claims must be shown in the structure claimed and not merely upon a use, function, or result thereof."). Indeed, "[t]he inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not." *Roberts v. Ryer*, 91 U.S. 150, 157 (1875). More specifically, this means that a patent grants the right to exclude others from making, using, selling, offering to sale, or importing the claimed apparatus or composition for any use of that apparatus or composition, whether or not the patentee envisioned such use. See 35 U.S.C. § 271 (1994). Again, statements of intended use or asserted benefits in the preamble may, in rare instances, limit apparatus claims, but only if the applicant clearly and unmistakably relied on those uses or benefits to distinguish prior art. Likewise, this principle does not mean that apparatus claims necessarily prevent a subsequent inventor from obtaining a patent on a new method of using the apparatus where that new method is useful and nonobvious (*Catalina Marketing International, Inc. v. Coolsavings.Com, Inc.* CAFC, 01-1324, 5/8/2002).

10. Concerning the applicant's second argument, that additional components taught in the prior art would have a detrimental effect on the instant composition, it is suggested that the applicant excluded additional ingredients by changing the transitional phrase "comprising" to "consisting of." as such closed language would exclude additional components.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703)308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



Gregory E. Webb
Examiner
Art Unit 1751

gw
October 22, 2002